UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,794	08/24/2000	Robert Wallach	4090-4002	3551

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EXAMINER
FRENEL, VANEL

ART UNIT	PAPER NUMBER
3626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.		Applicant(s)	
Office Action Summary	09/645,794		WALLACH ET AL.	
	Examiner		Art Unit	
	Vanel Frenel		3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*29 December 2003*</u> .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-78* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-78* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>*7*</u> .	6) ☐ Other: .

DETAILED ACTION

Notice to Applicant

1.   This communication is in response to the amendment filed 12/29/03. Claims 12-

78 are have been newly added. Claims 1-78 are pending.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

3.   Claims 13, 23, 33, 43, 52, 54-55, 65, 68 and 76 are rejected under 35 U.S.C. 101

because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

In the present case, claims 13, 23, 33, 43, 52, 54-55, 65, 68 and 76 are non-

statutory. Among this group only claim 54 recites "a computer- readable medium

encoded with processing instructions for implemented a method" in its preamble but

does not recite any technological device in the body of the claim in performing the

various steps of "processing" within the computer system.

As to technological arts recited in the preamble, mere recitation in the preamble

(i.e., intended or field of use) or mere implication of employing a machine or article of

manufacture to perform some or all of the recited steps does not confer statutory

subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

As per claims 13, 23, 33, 43, 52, 54-55, 65, 68 and 76, Examiner respectfully requests a clear and definite language tying the body of the claim to a technological device such as a computer, and not merely in the preamble.

As per claim 54, Examiner respectfully submits that the recited "computer-readable medium" is utilized in a trivial manner (i.e., passively recorded). In order to pass muster under 35 U.S.C. 101, the recited technological device must be employed in a non-trivial manner (e.g.,), "for producing a sale and lease of an item".

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is "a computer system". Looking at the claims 13, 23, 33, 43, 52, 54-55, 65, 68 and 76 as a whole, nothing in the body of the claims recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed

invention produces a sale and lease of an item (i.e., repeatable) used in helping buyer

to calculate a premium (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result,

since the claimed invention, as a whole, is not within the technological arts as explained

above, claims 13, 23, 33, 43, 52, 54-55, 65, 68 and 76 are deemed to be directed to

non-statutory subject matter.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-10, 12,16-22, 26-32 and 36-42 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Joao (6,347,302) in view of Borghesi et al (5,950169).

(A)   As per claim 1, Joao discloses a method for billing a flat, recurring charge to a

buyer for financing and insurance after a sale of an item, comprising:

receiving a first indication of a sale or lease of an item to a buyer (Col.10, lines

58-67 to Col.11, line 60); receiving a second indication of an insurance premium and a

financial balance owed by the buyer corresponding to the sale or lease (Col.10, lines

58-67 to Col.11, line 60); receiving a third indication of a predetermined time in which

the financial balance is to be paid (Col.1, lines 6-65).

Joao does not explicitly disclose calculating on a computer a periodic recurring amount based on the insurance premium, the financial balance and the predetermined time; and receiving, from the buyer, a single payment corresponding to the periodic recurring amount within the predetermined time.

However, these features are known in the art, as evidenced by Borghesi. In particular, Borghesi suggests calculating on a computer a periodic recurring amount based on the insurance premium, the financial balance and the predetermined time; and receiving, from the buyer, a single payment corresponding to the periodic recurring amount within the predetermined time (Col.15, lines 8-67 to Col.16, line 65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Borghesi within the system of Joao with the motivation of processing insurance claims in a predefined workflow for accommodation in the insurance industry (Col.1, lines 33-35 of Borghesi).

(B)   As per claim 2, Joao discloses the method wherein the predetermined time is based on a length of a loan for the financial balance owed by the buyer (Col.3, lines 56-67 to Col.4, line 39).

(C)   As per claim 3, Joao discloses the method of wherein the predetermined time is based on a length of a lease for the item (Col.1, lines 6-67 to Col.2, line 5).

(D)   As per claim 4, Borghesi discloses the method wherein the predetermined time is greater than one year (The Examiner interprets "the event log, which is attached to the datafile, preferably automatically puts a time and date stamp on certain predetermined tasks or activities as a form of the predetermined time is greater than one year See Borghesi, Col.15, lines 8-38).

(E)   As per claim 5, Borghesi discloses the method wherein the item is an automobile (Col.9, lines 57-67 to Col.10, line 28).

The combination for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claim 1, and incorporated herein.

(F)   As per claim 6, Joao discloses the method wherein the periodic, recurring amount is charged monthly (Col.2, lines 58-67).

(G)   As per claim 7, Joao discloses the method further comprising:

receiving a fourth indication of an interest rate to be applied to at least one of the financial balance and the insurance premium (Col.10, lines 58-67 to Col.11, line 60), wherein said calculating further calculating the periodic recurring amount further based on the interest rate (Col.13, lines 44-67 to Col.14, line 48).

(H)   As per claim 12, Joao discloses the method wherein said sale comprises a lease of the item (Col.1, lines 6-67 to Col.2, line 5).

(I)   As per claim 8, Joao discloses a method for billing a flat, recurring amount to a buyer covering financing and insurance after a sale of an item, comprising:

receiving a first indication of a sale or lease of an item to a buyer, a financial balance owed for the item and a predetermined time in which the financial balance is to be paid (Col.10, lines 58-67 to Col.11, line 60);

receiving a second indication of an insurance premium owed for an insurance policy covering the item for at least a portion of the predetermined time (;Col.10, lines 58-67 to Col.11, line 60); paying the insurance premium on behalf of the buyer (Col.14, lines 38-67).

Joao does not explicitly disclose calculating on a computer a periodic recurring amount for at least a portion of the predetermined time, the periodic recurring amount including a first amount corresponding to the financial balance and a second amount corresponding to the insurance premium; and receiving, from the buyer, a payment corresponding to the periodic recurring amount within the predetermined time.

However, these features are known in the art, as evidenced by Borghesi. In particular, Borghesi suggests calculating on a computer a periodic recurring amount for at least a portion of the predetermined time, the periodic recurring amount including a first amount corresponding to the financial balance and a second amount corresponding to the insurance premium; and receiving, from the buyer, a payment corresponding to the periodic recurring amount within the predetermined time (Col.15, lines 8-67 to Col.16, line 65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Borghesi within the system of Joao with the motivation of processing insurance claims in a predefined workflow for accommodation in the insurance industry (Col.1, lines 33-35 of Borghesi).

(J)   As per claim 9, Joao discloses a method for promoting the sale of an item, comprising: providing a first indication of an item for sale or lease (Col.10, lines 58-67 to Col.11, line 60); providing a second indication of a predetermined time to pay a financial balance corresponding to the item (Col.10, lines 58-67 to Col.11, line 60); and providing a third indication of an offer to charge a periodic recurring amount calculated on a computer system corresponding to a first payment of an insurance premium and a second payment (Col.8, lines 12-67).

Joao does not explicitly discloses a financing amount corresponding to the item, the insurance premium corresponding to an insurance policy covering the item, the periodic payment to recur for at least a portion of the predetermined time.

However, these features are known in the art, as evidenced by Borghesi. In particular, Borghesi suggests a financing amount corresponding to the item, the insurance premium corresponding to an insurance policy covering the item, the periodic payment to recur for at least a portion of the predetermined time (Col.15, lines 8-67 to Col.16, line 65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Borghesi within the system of Joao with the

motivation of processing insurance claims in a predefined workflow for accommodation

in the insurance industry (Col.1, lines 33-35 of Borghesi).

(K)   As per claim 10, Joao discloses a method for receiving an insurance premium for

an insurance policy covering an item, comprising: receiving a first indication of an item

to be covered under an insurance policy (Col.10, lines 58-67 to Col.11, line 60);

receiving a second indication of a buyer of the item (Col.10, lines 58-67 to Col.11, line

60); receiving a third indication of a predetermined time in which the buyer must pay a

financial balance corresponding to the item, the financial balance corresponding to a

loan amount or a lease amount (Col.8, lines 12-67).

Joao does not disclose calculating on a computer system an insurance premium

for the entire predetermined time based on the item and the buyer; and receiving, from

a party other than the buyer, a payment of the insurance.

However, these features are known in the art, as evidenced by Borghesi. In

particular, Borghesi suggests calculating on a computer system an insurance premium

for the entire predetermined time based on the item and the buyer; and receiving, from

a party other than the buyer, a payment of the insurance (Col.15, lines 8-67 to Col.16,

line 65).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the features of Borghesi within the system of Joao with the

motivation of processing insurance claims in a predefined workflow for accommodation

in the insurance industry (Col.1, lines 33-35 of Borghesi).

6.   Claims 11, 13-15, 23-25, 33-35, 43-51 and 52-78 are rejected under 35 U.S.C.

103(a) as being unpatentable over Joao (6,347,302) in view of Ryan et al (6,304,859).

(A)   As per claim 11, Joao discloses buying or leasing an item from a retailer, the item

having a corresponding finance amount and an insurance premium amount (Col.6, lines

34-67; Col.10, lines 10-65).

Joao does not explicitly disclose a method for simultaneously paying a financial

loan and insurance corresponding to an item; the finance amount corresponding to a

loan payment as part of a loan obtained for buying the item or a lease payment as part

of a lease for the item and payable over a predetermined time, the insurance premium

amount corresponding to an insurance policy having a term equal to the predetermined

time; and submitting a payment corresponding to a recurring amount which is

calculating on a computer for at least a portion of the finance amount and a portion of

the insurance premium amount within the predetermined time.

However, these features are known in the art, as evidenced by Ryan. In

particular, Ryan suggests a method for simultaneously paying a financial loan and

insurance corresponding to an item (Col.4, lines 21-67;Col.6, lines 40-67) the finance

amount corresponding to a loan payment as part of a loan obtained for buying the item

or a lease payment as part of a lease for the item and payable over a predetermined

time, the insurance premium amount corresponding to an insurance policy having a

term equal to the predetermined time (Col.4, lines 21-67;Col.6, lines 40-67); and

submitting a payment corresponding to the recurring amount which is calculating on a

computer for at least a portion of the finance amount and a portion of the insurance premium amount within the predetermined time (Col.4, lines 21-67;Col.6, lines 40-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Ryan within the system of Joao with the motivation of providing a system performing three processes which ideally occur simultaneously, namely, 1) optimal premium determination, 2) current cash value monitoring, and 3) periodic reporting (See Ryan, Col.5, lines 16-19).

(B)   As per claim 13, Joao discloses an apparatus for billing a flat, recurring charge to a buyer for financing and insurance after a sale of an item, comprising: means for receiving a first indication of a sale or lease of an item to a buyer (Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65); means for receiving a second indication of an insurance premium and a financial balance owed by the buyer corresponding to the sale or lease (Col.9, lines 15-67 to Col.10, line 67); means for receiving a third indication of a predetermined time in which the financial balance is to be paid (Col.8, lines 12-67). Joao does not explicitly disclose means for calculating a periodic recurring amount based on the insurance premium, the financial balance and the predetermined time; and means for receiving, from the buyer, a single payment corresponding to the periodic recurring amount within the predetermined time.

However, these features are known in the art, as evidenced by Ryan. In particular, Ryan suggests means for calculating a periodic recurring amount based on the insurance premium, the financial balance and the predetermined time; and means for receiving, from the buyer, a single payment corresponding to the periodic recurring

amount within the predetermined time (See Ryan, Col.3, lines 47-67 to Col.4, line 67; Col.13, lines 13-67 to Col.14, line 6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Ryan within the system of Joao with the motivation of providing a system performing three processes which ideally occur simultaneously, namely, 1) optimal premium determination, 2) current cash value monitoring, and 3) periodic reporting (See Ryan, Col.5, lines 16-19).

(C)   As per claim 14, Joao discloses an apparatus for billing a flat, recurring charge to a buyer for financing and insurance after a sale of an item (Col.6, lines 34-67; Col.10, lines 10-65), comprising: a processor (Col.11, lines 22-31); and a memory in communication with the processor, the memory for storing a plurality of processing instructions enabling the processor to: receive a first indication of a sale or lease of an item to a buyer (Col.15, lines 49-67 to Col.16, line 65); receive a second indication of an insurance premium and a financial balance owed by the buyer corresponding to the sale or lease (Col.15, lines 49-67 to Col.16, line 65); receive a third indication of a predetermined time in which the financial balance is to be paid (Col.15, lines 49-67 to Col.16, line 65).

Joao does not explicitly disclose calculate a periodic recurring amount based on the insurance premium, the financial balance and the predetermined time; and receive, from the buyer, a single payment corresponding to the periodic recurring amount within the predetermined time.

However, these features are known in the art, as evidenced by Ryan. In particular, Ryan suggests calculate a periodic recurring amount based on the insurance premium, the financial balance and the predetermined time (Col.4, lines 21-67; Col.6, lines 40-67); and receive, from the buyer, a single payment corresponding to the periodic recurring amount within the predetermined time (Col.4, lines 21-67; Col.6, lines 40-67; Col.12, lines 1-67; Col.13, lines 1- 67 to Col.14, line 67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Ryan within the system of Joao with the motivation of providing a system performing three processes which ideally occur simultaneously, namely, 1) optimal premium determination, 2) current cash value monitoring, and 3) periodic reporting (See Ryan, Col.5, lines 16-19).

(D)   Claim 15 differs from claims 1, 8-11, 13 and 14 by reciting a computer-readable medium encoded with processing instructions for implementing a method, performed by a computer, for billing a flat, recurring charge to a buyer for financing and insurance after a sale of an item.

As per this limitation, it is noted that Joao discloses comprising: receiving a first indication of a sale or lease of an item to a buyer (Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65); receiving a second indication of an insurance premium and a financial balance owed by the buyer corresponding to the sale or lease (Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65); receiving a third indication of a predetermined time in which the financial balance is to be paid (Col.5, lines 59-67 to Col.6, lines 67;

Col.10, lines 10-65) and Ryan discloses calculating a periodic recurring amount based on the insurance premium, the financial balance and the predetermined time; and receiving, from the buyer, a single payment corresponding to the periodic recurring amount within the predetermined time (Col.4, lines 21-67; Col.6, lines 40-67; Col.12, lines 1-67; Col.13, lines 1- 67 to Col.14, line 67).

Thus, it is readily apparent these prior art systems utilize a computer-readable medium encoded with processing instructions for implementing a method, performed by a computer, for billing a flat, recurring charge to a buyer for financing and insurance after a sale of an item to perform their specified function.

The remainder of claim 15 is rejected for the same reason given above for claims 1, 8-11, 13 and 14, and incorporated herein.

(E)   As per claim 23, Joao discloses an apparatus for billing a flat, recurring amount to a buyer covering financing and insurance after a sale of an item, comprising: means for receiving a first indication of a sale or lease of an item to a buyer, a financial balance owed for the item and a predetermined time in which the financial balance is to be paid (Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65); means for receiving a second indication of an insurance premium owed for an insurance policy covering the item for at least a portion of the predetermined time (Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65); means for paying the insurance premium on behalf of the buyer (Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65).

Joao does not explicitly disclose means for calculating a periodic recurring

amount for at least a portion of the predetermined time, the periodic recurring amount

including a first amount corresponding to the financial balance and a second amount

corresponding to the insurance premium; and means for receiving, from the buyer, a

payment corresponding to the periodic recurring amount within the predetermined time.

However, these features are known in the art, as evidenced by Ryan. In

particular, Ryan suggests means for calculating a periodic recurring amount for at least

a portion of the predetermined time, the periodic recurring amount including a first

amount corresponding to the financial balance and a second amount corresponding to

the insurance premium; and means for receiving, from the buyer, a payment

corresponding to the periodic recurring amount within the predetermined time (Col.4,

lines 21-67; Col.6, lines 40-67; Col.12, lines 1-67; Col.13, lines 1- 67 to Col.14, line 67).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the features of Ryan within the system of Joao with the

motivation of providing a system performing three processes which ideally occur

simultaneously, namely, 1) optimal premium determination, 2) current cash value

monitoring, and 3) periodic reporting (See Ryan, Col.5, lines 16-19).

(F)   As per claim 24, Joao discloses an apparatus for billing a flat, recurring amount

to a buyer covering financing and insurance after a sale of an item (Col.6, lines 34-67;

Col.10, lines 10-65) comprising: a processor (Col.11, lines 22-31); and a memory in

communication with the processor, the memory for storing a plurality of processing

instructions enabling the processor to: receive a first indication of a sale or lease of an item to a buyer, a financial balance owed for the item and a predetermined time in which the financial balance is to be paid (Col.15, lines 49-67 to Col.16, line 65); receive a second indication of an insurance premium owed for an insurance policy covering the item for at least a portion of the predetermined time (Col.15, lines 49-67 to Col.16, line 65); enable payment of the insurance premium on behalf of the buyer (Col.15, lines 49-67 to Col.16, line 65).

Joao does not explicitly disclose calculate a periodic recurring amount for at least a portion of the predetermined time, the periodic recurring amount including a first amount corresponding to the financial balance and a second amount corresponding to the insurance premium; and receive, from the buyer, a payment corresponding to the periodic recurring amount within the predetermined time.

However, these features are known in the art, as evidenced by Ryan. In particular, Ryan suggests calculate a periodic recurring amount for at least a portion of the predetermined time, the periodic recurring amount including a first amount corresponding to the financial balance and a second amount corresponding to the insurance premium; and receive, from the buyer, a payment corresponding to the periodic recurring amount within the predetermined time (Col.4, lines 21-67; Col.6, lines 40-67; Col.12, lines 1-67; Col.13, lines 1- 67 to Col.14, line 67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Ryan within the system of Joao with the motivation of providing a system performing three processes which ideally occur

simultaneously, namely, 1) optimal premium determination, 2) current cash value monitoring, and 3) periodic reporting (See Ryan, Col.5, lines 16-19).

(G)   Claim 25 differs from claims 1, 8-11, 13 –15, and 23-24 by reciting a computer-readable medium encoded with processing instructions for implementing a method, performed by a computer, for billing a flat, recurring amount to a buyer covering financing and insurance after a sale of an item.

As per this limitation it is noted that Joao discloses the method comprising: receiving a first indication of a sale or lease of an item to a buyer, a financial balance owed for the item and a predetermined time in which the financial balance is to be paid (Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65); receiving a second indication of an insurance premium owed for an insurance policy covering the item for at least a portion of the predetermined time (Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65); paying the insurance premium on behalf of the buyer (Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65) and Ryan discloses calculating a periodic recurring amount for at least a portion of the predetermined time, the periodic recurring amount including a first amount corresponding to the financial balance and a second amount corresponding to the insurance premium; and receiving, from the buyer, a payment corresponding to the periodic recurring amount within the predetermined time (Col.4, lines 21-67; Col.6, lines 40-67; Col.12, lines 1-67; Col.13, lines 1- 67 to Col.14, line 67).

Thus, it is readily apparent these prior art systems utilize a computer-readable medium encoded with processing instructions for implementing a method, performed by

a computer, for billing a flat, recurring amount to a buyer covering financing and insurance after a sale of an item to perform their specified function.

The remainder of claim 25 is rejected for the same reason given above for claims 1, 8-11, 13-15 and 23-24, and incorporated herein.

(H)   Claim 33 differs from claims 1, 8-11,13-15 and 23-25 by reciting an apparatus for promoting the sale of an item.

As per this limitation, it is noted that Joao discloses comprising: means for providing a first indication of an item for sale or lease (Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65); means for providing a second indication of a predetermined time to pay a financial balance corresponding to the item Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65); and means for providing a third indication of an offer to charge a periodic recurring amount corresponding to a first payment of an insurance premium and a second payment of a financing amount corresponding to the item Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65) and Ryan discloses the insurance premium corresponding to an insurance policy covering the item, the periodic payment to recur for at least a portion of the predetermined time (Col.4, lines 21-67; Col.6, lines 40-67; Col.12, lines 1-67; Col.13, lines 1- 67 to Col.14, line 67).

Thus, it is readily apparent these prior art systems utilize an apparatus for promoting the sale of an item to perform their specified function.

The remainder of claim 33 is rejected for the same reason given above for claims 1, 8-11, 13-15 and 23-25, and incorporated herein.

(I)   As per claim 34, Joao discloses an apparatus for promoting the sale of an item

(Col.6, lines 34-67; Col.10, lines 10-65), comprising: a processor (Col.11, lines 22-31);

and a memory in communication with the processor, the memory for storing a plurality

of processing instructions enabling the processor to: provide a first indication of an item

for sale or lease (Col.15, lines 49-67 to Col.16, line 65); provide a second indication of a

predetermined time to pay a financial balance corresponding to the item (Col.15, lines

49-67 to Col.16, line 65); and provide a third indication of an offer to charge a periodic

recurring amount corresponding to a first payment of an insurance premium and a

second payment of a financing amount corresponding to the item (Col.15, lines 49-67 to

Col.16, line 65).

Joao does not explicitly disclose the insurance premium corresponding to an

insurance policy covering the item, the periodic payment to recur for at least a portion of

the predetermined time.

However, this feature is known in the art, as evidenced by Ryan. In particular,

Ryan suggests the insurance premium corresponding to an insurance policy covering

the item, the periodic payment to recur for at least a portion of the predetermined time

(Col.4, lines 21-67; Col.6, lines 40-67; Col.12, lines 1-67; Col.13, lines 1- 67 to Col.14,

line 67).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the features of Ryan within the system of Joao with the

motivation of providing a system performing three processes which ideally occur

simultaneously, namely, 1) optimal premium determination, 2) current cash value monitoring, and 3) periodic reporting (See Ryan, Col.5, lines 16-19).

(J)   Claim 35 differs from claims 1, 8-11, 13-15, 23-25 and 33-34 by reciting a computer-readable medium encoded with processing instructions for implementing a method, performed by a computer, for promoting the sale of an item.

As per this limitation, it is noted that Joao discloses the method comprising: providing a first indication of an item for sale or lease (Col.5, lines 59-67 to Col.6, line 67); providing a second indication of a predetermined time to pay a financial balance corresponding to the item (Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65); and providing a third indication of an offer to charge a periodic recurring amount corresponding to a first payment of an insurance premium and a second payment of a financing amount corresponding to the item (Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65) and Ryan discloses the insurance premium corresponding to an insurance policy covering the item, the periodic payment to recur for at least a portion of the predetermined time (Col.4, lines 21-67; Col.6, lines 40-67; Col.12, lines 1-67; Col.13, lines 1- 67 to Col.14, line 67).

Thus, it is readily apparent these prior art systems utilize a computer-readable medium encoded with processing instructions for implementing a method, performed by a computer, for promoting the sale of an item to perform their specified function.

The remainder of claim 35 is rejected for the same reason given above for claims 1, 8-11, 13-15 and 23-25 and 33-34, and incorporated herein.

(K)   As per claim 43, Joao discloses a method for billing a flat, recurring charge to a

buyer for financing and insurance after a sale of an item, comprising: receiving a first

indication of one of a sale and lease of an item to a buyer (Col.5, lines 59-67 to Col.6,

lines 67; Col.10, lines 10-65); receiving a second indication of an insurance premium

and a financial balance owed by the buyer corresponding to the sale or lease (Col.5,

lines 59-67 to Col.6, lines 67; Col.10, lines 10-65); receiving a third indication of a

predetermined time in which the financial balance is to be paid (Col.5, lines 59-67 to

Col.6, lines 67; Col.10, lines 10-65).

Joao does not explicitly disclose calculating a periodic recurring amount based

on the insurance premium, the financial balance and the predetermined time.

However, this feature is known in the art, as evidenced by Ryan. In particular,

Ryan suggests calculating a periodic recurring amount based on the insurance

premium, the financial balance and the predetermined time (Col.4, lines 21-67; Col.6,

lines 40-67; Col.12, lines 1-67; Col.13, lines 1- 67 to Col.14, line 67).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the features of Ryan within the system of Joao with the

motivation of providing a system performing three processes which ideally occur

simultaneously, namely, 1) optimal premium determination, 2) current cash value

monitoring, and 3) periodic reporting (See Ryan, Col.5, lines 16-19).

(L)   As per claim 52, Joao discloses an apparatus for billing a flat, recurring charge to

a buyer for financing and insurance after a sale of an item, comprising: means for

receiving a first indication of one of: a sale and lease of an item to a buyer (Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65); means for receiving a second indication of an insurance premium and a financial balance owed by the buyer corresponding to the sale or lease (Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65); means for receiving a third indication of a predetermined time in which the financial balance is to be paid (Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65).

Joao does not explicitly disclose means for calculating a periodic recurring amount based on the insurance premium, the financial balance and the predetermined time.

However, this feature is known in the art, as evidenced by Ryan. In particular, Ryan suggests means for calculating a periodic recurring amount based on the insurance premium, the financial balance and the predetermined time (Col.4, lines 21-67; Col.6, lines 40-67; Col.12, lines 1-67; Col.13, lines 1- 67 to Col.14, line 67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Ryan within the system of Joao with the motivation of providing a system performing three processes which ideally occur simultaneously, namely, 1) optimal premium determination, 2) current cash value monitoring, and 3) periodic reporting (See Ryan, Col.5, lines 16-19).

(M)   As per claim 53, Joao discloses an apparatus for billing a flat, recurring charge to a buyer for financing and insurance after a sale of an item, comprising: a processor (Col.11, lines 22-31); and a memory in communication with the processor, the memory

for storing a plurality of processing instructions enabling the processor to: receive a first

indication of one of: a sale and lease of an item to a buyer (Col.15, lines 49-67 to

Col.16, line 65); receive a second indication of an insurance premium and a financial

balance owed by the buyer corresponding to the sale or lease (Col.15, lines 49-67 to

Col.16, line 65); receive a third indication of a predetermined time in which the financial

balance is to be paid (Col.15, lines 49-67 to Col.16, line 65).

Joao does not explicitly disclose calculate a periodic recurring amount based on

the insurance premium, the financial balance and the predetermined time.

However, this feature is known in the art, as evidenced by Ryan. In particular,

Ryan suggests calculate a periodic recurring amount based on the insurance premium,

the financial balance and the predetermined time (Col.4, lines 21-67; Col.6, lines 40-67;

Col.12, lines 1-67; Col.13, lines 1- 67 to Col.14, line 67).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the features of Ryan within the system of Joao with the

motivation of providing a system performing three processes which ideally occur

simultaneously, namely, 1) optimal premium determination, 2) current cash value

monitoring, and 3) periodic reporting (See Ryan, Col.5, lines 16-19).

(N)   As per claim 54, Joao discloses a computer-readable medium encoded with

processing instructions for implementing a method, performed by a computer, for billing

a flat, recurring charge to a buyer for financing and insurance after a sale of an item, the

method comprising: receiving a first indication of one of a sale and lease of an item to a

buyer (Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65); receiving a second

indication of an insurance premium and a financial balance owed by the buyer

corresponding to the sale or lease (Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-

65); receiving a third indication of a predetermined time in which the financial balance is

to be paid (Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65).

Joao does not explicitly disclose calculating a periodic recurring amount based

on the insurance premium, the financial balance and the predetermined time.

However, this feature is known in the art, as evidenced by Ryan. In particular,

Ryan suggests calculating a periodic recurring amount based on the insurance

premium, the financial balance and the predetermined time (Col.4, lines 21-67; Col.6,

lines 40-67; Col.12, lines 1-67; Col.13, lines 1- 67 to Col.14, line 67).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the features of Ryan within the system of Joao with the

motivation of providing a system performing three processes which ideally occur

simultaneously, namely, 1) optimal premium determination, 2) current cash value

monitoring, and 3) periodic reporting (See Ryan, Col.5, lines 16-19).

(O)   As per claim 55, Joao discloses a method for billing a flat, recurring amount to a

buyer covering financing and insurance after a sale of an item, comprising: receiving a

first indication of a sale or lease of an item to a buyer, a financial balance owed for the

item and a predetermined time in which the financial balance is to be paid (Col.5, lines

59-67 to Col.6, lines 67; Col.10, lines 10-65); receiving a second indication of an

insurance premium owed for an insurance policy covering the item for at least a portion

of the predetermined time (Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65).

Joao does not explicitly disclose calculating a periodic recurring amount for at

least a portion of the predetermined time, the periodic recurring amount including a first

amount corresponding to the financial balance and a second amount corresponding to

the insurance premium.

However, this feature is known in the art, as evidenced by Ryan. In particular,

Ryan suggests calculating a periodic recurring amount for at least a portion of the

predetermined time, the periodic recurring amount including a first amount

corresponding to the financial balance and a second amount corresponding to the

insurance premium (Col.4, lines 21-67; Col.6, lines 40-67; Col.12, lines 1-67; Col.13,

lines 1- 67 to Col.14, line 67).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the features of Ryan within the system of Joao with the

motivation of providing a system performing three processes which ideally occur

simultaneously, namely, 1) optimal premium determination, 2) current cash value

monitoring, and 3) periodic reporting (See Ryan, Col.5, lines 16-19).

(P)   (P)   As per claim 65, Joao discloses an apparatus for billing a flat, recurring amount

to a buyer covering financing and insurance after a sale of an item, comprising: means

for receiving a first indication of a sale or lease of an item to a buyer, a financial balance

owed for the item and a predetermined time in which the financial balance is to be paid

(Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65); means for receiving a second

indication of an insurance premium owed for an insurance policy covering the item for at

least a portion of the predetermined time (Col.5, lines 59-67 to Col.6, lines 67; Col.10,

lines 10-65); and means for calculating a periodic recurring amount for at least a portion

of the predetermined time (Col.5, lines 59-67 to Col.6, lines 67; Col.10, lines 10-65).

Joao does not explicitly disclose the periodic recurring amount including a first amount

corresponding to the financial balance and a second amount corresponding to the

insurance premium.

However, this feature is known in the art, as evidenced by Ryan. In particular,

Ryan suggests the periodic recurring amount including a first amount corresponding to

the financial balance and a second amount corresponding to the insurance premium

(Col.4, lines 21-67; Col.6, lines 40-67; Col.12, lines 1-67; Col.13, lines 1- 67 to Col.14,

line 67).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the features of Ryan within the system of Joao with the

motivation of providing a system performing three processes which ideally occur

simultaneously, namely, 1) optimal premium determination, 2) current cash value

monitoring, and 3) periodic reporting (See Ryan, Col.5, lines 16-19).

(Q)   As per claim 66, Joao discloses an apparatus for billing a flat, recurring amount

to a buyer covering financing and insurance after a sale of an item, comprising: a

processor (Col.11, lines 22-31); and a memory in communication with the processor,

the memory for storing a plurality of processing instructions enabling the processor to:

receive a first indication of a sale or lease of an item to a buyer, a financial balance

owed for the item and a predetermined time in which the financial balance is to be paid

(Col.15, lines 49-67 to Col.16, line 65); receive a second indication of an insurance

premium owed for an insurance policy covering the item for at least a portion of the

predetermined time (Col.15, lines 49-67 to Col.16, line 65).

Joao does not explicitly disclose calculate a periodic recurring amount for at

least a portion of the predetermined time, the periodic recurring amount including a first

amount corresponding to the financial balance and a second amount corresponding to

the insurance premium.

However, this feature is known in the art, as evidenced by Ryan. In particular,

Ryan suggests calculate a periodic recurring amount for at least a portion of the

predetermined time, the periodic recurring amount including a first amount

corresponding to the financial balance and a second amount corresponding to the

insurance premium (Col.4, lines 21-67; Col.6, lines 40-67; Col.12, lines 1-67; Col.13,

lines 1- 67 to Col.14, line 67).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the features of Ryan within the system of Joao with the

motivation of providing a system performing three processes which ideally occur

simultaneously, namely, 1) optimal premium determination, 2) current cash value

monitoring, and 3) periodic reporting (See Ryan, Col.5, lines 16-19).

(R)   As per claim 67, Joao discloses a computer-readable medium encoded with

processing instructions for implementing a method, performed by a computer, for billing

a flat, recurring amount to a buyer covering financing and insurance after a sale of an

item, the method comprising: receiving a first indication of a sale or lease of an item to a

buyer, a financial balance owed for the item and a predetermined time in which the

financial balance is to be paid (Col.15, lines 49-67 to Col.16, line 65); receiving a

second indication of an insurance premium owed for an insurance policy covering the

item for at least a portion of the predetermined time; and calculating a periodic

recurring amount for at least a portion of the predetermined time Col.15, lines 49-67 to

Col.16, line 65).

Joao does not explicitly disclose the periodic recurring amount including a first

amount corresponding to the financial balance and a second amount corresponding to

the insurance premium.

However, this feature is known in the art, as evidenced by Ryan. In particular,

Ryan suggests the periodic recurring amount including a first amount corresponding to

the financial balance and a second amount corresponding to the insurance premium

(Col.4, lines 21-67; Col.6, lines 40-67; Col.12, lines 1-67; Col.13, lines 1- 67 to Col.14,

line 67).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the features of Ryan within the system of Joao with the

motivation of providing a system performing three processes which ideally occur

simultaneously, namely, 1) optimal premium determination, 2) current cash value monitoring, and 3) periodic reporting (See Ryan, Col.5, lines 16-19).

(S)   Claim 68 differs from claims 1, 8-11, 13-15 and 23-25, 33-35, 43, 52-55, 65-67 by reciting a method for determining an insurance premium for an insurance policy covering an item.

As per this limitation, it is noted that Joao discloses comprising: receiving a first indication of an item to be covered under an insurance policy (Col.15, lines 49-67 to Col.16, line 65); receiving a second indication of a buyer of the item (Col.15, lines 49-67 to Col.16, line 65); receiving a third indication of a predetermined time in which the buyer must pay a financial balance corresponding to the item, the financial balance corresponding to a loan amount or a lease amount (Col.15, lines 49-67 to Col.16, line 65) and Ryan discloses calculating an insurance premium for the entire predetermined time based on the item and the buyer (Col.4, lines 21-67; Col.6, lines 40-67; Col.12, lines 1-67; Col.13, lines 1- 67 to Col.14, line 67).

Thus, it is readily apparent these prior art systems utilize a method for determining an insurance premium for an insurance policy covering an item to perform their specified function.

Therefore, the remainder of claim 68 is rejected for the same reason given above for claims 1, 8-11, 13-15 and 23-25 and 33-35, 43, 52-55, 65-67, and incorporated herein.

(T)   As per claim 76, Joao discloses an apparatus for determining an insurance

premium for an insurance policy covering an item, comprising: means for receiving a

first indication of an item to be covered under an insurance policy (Col.15, lines 49-67 to

Col.16, line 65); means for receiving a second indication of a buyer of the item (Col.15,

lines 49-67 to Col.16, line 65); means for receiving a third indication of a predetermined

time in which the buyer must pay a financial balance corresponding to the item, the

financial balance corresponding to a loan amount or a lease amount (Col.15, lines 49-

67 to Col.16, line 65).

Joao does not explicitly disclose means for calculating an insurance premium for

the entire predetermined time based on the item and the buyer.

However, this feature is known in the art, as evidenced by Ryan. In particular,

Ryan suggests means for calculating an insurance premium for the entire

predetermined time based on the item and the buyer (Col.4, lines 21-67; Col.6, lines 40-

67; Col.12, lines 1-67; Col.13, lines 1- 67 to Col.14, line 67).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the features of Ryan within the system of Joao with the

motivation of providing a system performing three processes which ideally occur

simultaneously, namely, 1) optimal premium determination, 2) current cash value

monitoring, and 3) periodic reporting (See Ryan, Col.5, lines 16-19).

(U)   As per claim 77, Joao discloses an apparatus for determining an insurance

premium for an insurance policy covering an item, comprising: a processor (Col.11,

lines 22-31); and a memory in communication with the processor, the memory for

storing a plurality of processing instructions enabling the processor to: receive a first

indication of an item to be covered under an insurance policy; receive a second

indication of a buyer of the item (Col.15, lines 49-67 to Col.16, line 65); receive a third

indication of a predetermined time in which the buyer must pay a financial balance

corresponding to the item, the financial balance corresponding to a loan amount or a

lease amount (Col.15, lines 49-67 to Col.16, line 65).

Joao does not explicitly disclose calculate an insurance premium for the entire

predetermined time based on the item and the buyer.

However, this feature is known in the art, as evidenced by Ryan. In particular,

Ryan suggests calculate an insurance premium for the entire predetermined time based

on the item and the buyer (Col.4, lines 21-67; Col.6, lines 40-67; Col.12, lines 1-67;

Col.13, lines 1- 67 to Col.14, line 67).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the features of Ryan within the system of Joao with the

motivation of providing a system performing three processes which ideally occur

simultaneously, namely, 1) optimal premium determination, 2) current cash value

monitoring, and 3) periodic reporting (See Ryan, Col.5, lines 16-19).

(V)   Claim 78 differs from claims 1, 8-11, 13-15 and 23-25, 33-35, 43, 52-55, 65-68

and 76-77 by reciting a computer-readable medium encoded with processing

instructions for implementing a method, performed by a computer, for determining an

insurance premium for an insurance policy covering an item.

As per this limitation, it is noted that Joao discloses the method comprising: receiving a first indication of an item to be covered under an insurance policy (Col.15, lines 49-67 to Col.16, line 65); receiving a third indication of a predetermined time in which the buyer must pay a financial balance corresponding to the item, the financial balance corresponding to a loan amount or a lease amount (Col.15, lines 49-67 to Col.16, line 65) and Ryan discloses calculating an insurance premium for the entire predetermined time based on the item and the buyer (Col.4, lines 21-67; Col.6, lines 40-67; Col.12, lines 1-67; Col.13, lines 1- 67 to Col.14, line 67).

Thus, it is readily apparent these prior art systems utilize a computer-readable medium encoded with processing instructions for implementing a method, performed by a computer, for determining an insurance premium for an insurance policy covering an item to perform their specified function.

Therefore, the remainder of claim 78 is rejected for the same reason given above for claims 1, 8-11, 13-15 and 23-25, 33-35, 43, 52-55, 65-68 and 76-77, and incorporated herein.

(W)   Claims 16-21, 26-31, 36-42, 44-51, 56-64 and 69-75 recite the underlying process of the elements of claims 2-7, and respectively. As the various elements of claims 2-7 have been shown to be either disclosed by or obvious in view of the collective teachings of Joao, Borghesi and Ryan, it is readily apparent that the apparatus disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 16-21, 26-31, 36-42, 44-51, 56-64 and 69-75

are rejected for the same reasons given above for system claims 2-7, and incorporated

herein.

Response to Arguments

7.   Applicant's arguments filed on 12/29/03 regarding claims 1-11 have been fully

considered but they are not persuasive. Applicant's arguments will be addressed

hereinbelow in the order in which they appear in the response filed 12/29/03.

At pages 22-31 of the 12/29/03, Applicant's argues the followings:

(1) Neither Joao nor Borghesi taken alone or in combination, teaches or suggests

calculating a periodic recurring amount based on the insurance premium, the financial

balance, and the predetermined time and receiving from the buyer a single payment

corresponding to the periodic recurring amount.

(2) Borghesi does not teach or suggest calculating a periodic recurring amount

based on the insurance premium, the financial balance, and the predetermined time or

receiving from the buyer a single payment corresponding to the periodic recurring

amount with the predetermined time, as recited in independent claim 1.

(3) Joao does not explicitly disclose calculating a periodic amount for at least a

portion of the predetermined time, the periodic recurring amount including a first amount

corresponding to the financial balance and a second amount corresponding to the

insurance premium; and receiving from the buyer, a payment corresponding to the

periodic recurring amount within the predetermined time.

(4) Neither Joao nor Ryan teach or suggests a finance amount corresponding to a loan payment as part of a loan obtained for buying the item or a lease payment as part of a lease for leasing the item.

(5) Ryan patent does not teach or suggest simultaneously paying a financial loan and insurance corresponding to an item, wherein a financed amount that corresponds to a loan obtained to buy or lease an item is aggregated with an insurance premium amount for insuring the item into a calculated recurring amount.

(A)   With respect to Applicant's first argument, Examiner respectfully suggests that Joao discloses "The apparatus 100 also comprises a read only memory (ROM) 2 and a random access memory (RAM) 3 which are also connected to the CPU 1. The apparatus 100 also comprises a user input device(s) 4 which comprise(s) any one or more of a keyboard, a scanner, a user pointing device, such as, for example, a mouse, a touch pad, and/or an audio input device and/or a video input device, etc., if desired, which input device(s) are also be connected to the CPU 1. The apparatus 100 also comprises a display device 5, such as a display monitor, which is also connected to the CPU 1, and an output device 6, such as a printer, a fax/modem, etc., which output device is also connected to the CPU 1. The apparatus 100 also comprises a database(s) 7, wherein various information and/or data, which is utilized in the various processing routines, as will be described herein, is stored and which is also connected to, and accessible by, the CPU 1. Various data and/or information related to the leasing and/or rental of vehicles, motor vehicles, trucks, construction equipment, farm

equipment, boats, recreational vehicles, airplanes, aircraft, motorcycles, office

equipment, computers, computer equipment, and other articles and/or devices,

equipment, etc., including articles and/or equipment which may be utilized in, and/or in

conjunction with residential and/or commercial premises, is stored in the database 7.

The database 7 also includes data and/or information related to the leases of residential

and/or commercial property and/or premises. Data and/or information related to vehicle

leases, which is included in the database 7, includes vehicle year, model, vehicle

components and/or systems along with their repair costs, replacement costs, probability

of damage, probability of post-warranty repairs necessitated by wear and tear, damage,

malfunctioning components and/or systems and defects in materials, parts,

components, systems and/or workmanship, average costs for repairs, historical leasing

data, average total excess wear and tear and/or damage costs for the entire vehicle.

Vehicle leasing data and/or information also includes locality, regional and geographical

data which is correlated with excess wear and tear and/or damage costs along with data

and/or information which is related to driving and/or usage habits and/or patterns in a

given area or areas. Data and information related to individuals and/or business entities,

by region, occupation etc, including driving and/or usage habits, leasing histories, etc.,

will also be included in the database 7. Excess wear and tear and damage, as the terms

are used herein, refer to, and includes, any and all conditions and/or states of the

leased and/or rented entity, including but not limited to scratches, dents, tears, stains,

etc, malfunctioning and/or inoperable components and/or systems, state(s) of disrepair,

and any and all other states and/or conditions which will subject the lessor and/or renter

to any liability therefor at the end of the lease and/or rental term. Post-warranty repairs, as the term is used herein, includes any and all repairs which are made necessary from any wear and tear, normal or otherwise, to components and/or systems of the herein-described entities and further includes repairs which result from defects in materials and/or workmanship. Post-warranty repairs also include any and all repairs which would be covered under a manufacturer's warranty. In this regard, the apparatus and method of the present invention provides for extended warranty protection for the leased and/or rented entity for the duration of the lease or rental term. The database 7 also includes any and all data and/or information which will facilitate the calculation, determination and/or formulation of an insurance policy, product, service and/or coverage for providing extended warranty protection for any leased and/or rented entity described herein. The database 7 also includes data and/or information for particular individuals and/or business entities which includes personal, individual and/or organizational driving and/or usage patterns and/or driving and/or usage histories and leasing histories as well as any other information which an insurer may deem necessary and/or desirable in determining whether insurance should be offered and/or underwritten for an individual and/or business entity. Data and/or information related to the leasing and/or rental of any other leasable article and/or entity, such as, for example, personal, residential and/or commercial office equipment, computers, computer equipment, facsimile machines, copy machines, furniture, as well as any other article, piece of equipment and/or entity (hereinafter referred to as "leasable article"), which may be the subject of a lease or rental arrangement, is also included in the

database 7" which correspond to Applicant's claimed feature (See Joao, Col.5, lines 47-

67 to Col.6, line65). Therefore, Applicant's argument is not persuasive.

(B)   With respect to Applicant's first and second arguments, Examiner respectfully

suggests that obviousness is determined on the basis of the evidence as a whole and

the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445,

24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228

USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ

785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147

(CCPA 1976). Using this standard, the Examiner respectfully submits that he has at

least satisfied the burden of presenting a *prima facie* case of obviousness, since he has

presented evidence of corresponding claim elements in the prior art and has expressly

articulated the combinations and the motivations for combinations that fairly suggest

Applicant's claimed invention (see paper number 6) of the previous Office Action.

Moreover, in the instant case, the Examiner respectfully notes that each and every

motivation to combine the applied references are accompanied by select portions of the

respective reference(s) which specifically support that particular motivation and/or an

explanation based on the logic and scientific reasoning of one ordinarily skilled in the art

at the time of the invention that support a holding of obviousness. As such, it is NOT

seen that the Examiner's combination of references is unsupported by the applied prior

art of record. Rather, it is respectfully submitted that explanation based on the logic and

scientific reasoning of one ordinarily skilled in the art at the time of the invention that

support a holding of obviousness has been adequately provided by the motivations and

reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat.

App. & Inter., 4/22/93).

In addition, it must be recognized that any judgment on obviousness is in a sense

necessarily a reconstruction based upon hindsight reasoning. But so long as it takes

into account <u>only knowledge which was within the level of ordinary skill at the time the</u>

<u>claimed invention was made</u>, and does not include knowledge gleaned only from the

Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d

1392, 170 USPQ 209 (CCPA 1971).

(C)   With respect to Applicant's third argument, Examiner respectfully suggests Joao

discloses "Data and/or information related to vehicle leases, which is included in the

database 7, includes vehicle year, model, vehicle components and/or systems along

with their repair costs, replacement costs, probability of damage, probability of post-

warranty repairs necessitated by wear and tear, damage, malfunctioning components

and/or systems and defects in materials, parts, components, systems and/or

workmanship, average costs for repairs, historical leasing data, average total excess

wear and tear and/or damage costs for the entire vehicle. Vehicle leasing data and/or

information also includes locality, regional and geographical data which is correlated

with excess wear and tear and/or damage costs along with data and/or information

which is related to driving and/or usage habits and/or patterns in a given area or areas.

Data and information related to individuals and/or business entities, by region,

occupation etc, including driving and/or usage habits, leasing histories, etc., will also be included in the database 7" which correspond to Applicant's claimed feature (See Joao, Col.6, lines 7-25). Therefore, Applicant's argument's is not persuasive.

(D)   With respect to Applicant's fourth argument, Examiner respectfully submits that Joao suggests "The database 7 also comprises data and/or information related to insurance premiums which data and/or information is utilized to calculate and/or underwrite an insurance policy, depending upon the nature and the amount of coverage for the leased and/or rented entity of interest. The database 7 also contains statistical information related to sex, age, driving and use record histories for individuals and/or business entities which information can be utilized in insurance policy and/or premium determinations and calculations. The database 7 also comprises data and/or information concerning past lease experiences, if any, for individuals and business entities, including specific individuals and/or business entities, along with corresponding records concerning any end of lease damage and/or excess wear and tear which may have occurred in past leasing and/or rental relationships. The database 7 also contains data and/or information related to lease and or rental term, data and/or information related to geography, season, etc., along with data and/or information related to how these variables affect any other data and/or information described herein. The data and/or information which is stored in the database 7, in addition to the above data and/or information, contains any other necessary, recommended and/or supplemental data and/or information, and/or application program(s) which may be helpful and/or

desired by an insurer in determining whether to issue an insurance policy, product,

service and/or coverage described herein. The data and/or information which is stored

in the database 7 may be utilized to calculate risk, risk of loss and/or damage

probabilities for an individual and/or business entity, for any given lease or rental

situation, lease or rental entity and/or lease and/or rental agreement. The data and/or

information which is stored in the database 7 may be utilized to calculate risk, risk of

loss and/or damage probabilities for any of the leased and/or rented vehicles, articles

and/or premises described herein, for any individual and/or business entity and for any

given lease and/or rental situation. The present invention may be utilized to custom

design and/or calculate an insurance policy, product, service and/or coverage for a

particular lease or rental agreement and/or situation by utilizing risk, risk of loss, risk

assessment and underwriting techniques which can be modified for the particular

application. The data and/or information described herein will be utilized to generate

and underwrite an insurance policy as well as to calculate an insurance premium or

charges, depending upon the nature and the amount of the coverage desired for the

leased and/or rented entity. The data and/or information which is stored in the database

7 will be updated regularly so as to maintain the most accurate and current data as

possible" which correspond to Applicant's claimed feature (See Joao, Col.8, lines 12-

64). Therefore, Applicant's argument is not persuasive.

(E)   With respect to Applicant's fifth argument, Examiner respectfully submits that

Ryan discloses "Once a specific group of participants' policies are purchased, computer

system 100 begins simultaneously tracking the cash value growth of each individual

policy through the Performance Tracking Process 4. This process entails receiving

information on the actual returns of a policy 106 and storing the information in memory

2. Computer system 100 reads this information from memory 2 periodically and

generates report 10 for each individual participant. In addition, computer system 100

keeps track of each policy's performance and compares it against the projected

performance for that particular policy. This information is stored in memory 2 for use in

projecting the performance of policies purchased in the future. Simultaneously,

computer system 100 performs the Loan to Cash Value Monitoring Process 5. In this

process, computer system 100 receives information from the lending institution's

computer system 110, via modem 105. The lending institution provides a loan to finance

a portion of the variable life insurance premium. This information is stored in memory 2

and is used by computer system 100 to monitor the loan to cash value ratio for each

individual policy. Computer system 100 reads the loan information and cash value

information 7 for a particular participant's policy and determines the actual loan to cash

value ratio. Computer system 100 then reads the required maximum loan to cash value

ratio ("Required Maximum Ratio"), for this particular policy, from a data structure on its

computer memory 2 and compares it with the actual ratio. If the actual loan to cash

value for this particular policy is greater than the required maximum ratio, computer

system 100 causes a request for an adjustment to be made. This adjustment may

require additional cash contributions or a partial or full surrender of the policy. The

adjustment information is stored in computer memory 2, and is also transmitted to the

lending institution's computer system 110. The Loan to Cash Value Monitoring Process 5 is repeated until the actual loan to cash value ratio for each policy is less than or equal to the required maximum ratio. Computer system 100 then prepares and generates a report 11 with all pertinent information " which correspond to Applicant's claimed feature (See Ryan, Col.9, lines 66-67 to Col.10, line 36). Therefore, Applicant's argument is not persuasive.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 12/29/03 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Joao, Borghesi and/or Ryan based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 6), and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

8.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. The cited but not applied prior art teaches system and method for

analyzing and originating a contractual option arrangement for a bank deposits liabilities

base (6,363,360), motor vehicle monitoring system for determining a cost of insurance

(5,797,134), insurance verification system and method (6,233,563) and method and

apparatus for internet on-line insurance policy service (2002/0116228).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Vanel Frenel whose telephone number is 703-305-

4952. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone

numbers for the organization where this application or proceeding is assigned are 703-

305-7687 for regular communications and 703-305-7687 for After Final

communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-308-

1113.

V.F

V.F

April 5, 2004

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600